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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,612	08/05/2000	Ronald John Rosenberger		2637

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Ronald Rosenberger
506 Sterling Street
Newton, PA 18940

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,612

Applicant(s)

ROSENBERGER, RONALD JOHN

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 146-205 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 146-205 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2004 has been entered.

Response to Amendment

2. The amendment filed on October 23, 2003 is sufficient to overcome the 35 U.S.C. 103(a) rejection over the Bucci (5,655,089) and Byerly et al (6,067,524) references by canceling all of the rejected claims and adding claims 146-205.

Claim Rejections - 35 USC § 112

3. Claims 146-175 provide for the use of various means, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claims 146-175 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Exemplary is Claim 146 which is a method claim whose preamble recites "A method of providing...comprising". However, the body of the claim is in the format of a "means plus function" claim, e.g. "a. means for enabling an entity..." "b. means for providing said financial cards...", etc. which is used to define a system or apparatus claim. A method claim is required to specifically recite the steps of the process, e.g. "a. enabling an entity..." "b. providing said financial cards...", etc.

The claims will be considered in the Office Action below as if they were in proper format. However, appropriate correction is required in the next response.

Claim Rejections - 35 USC § 103

4. Claims 146-205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byerly et al (6,067,524) in view of Bucci (5,655,089) and Masuda (5,569,897).

Claims 146 and 176: Byerly discloses a system and method for providing health care reminders on billing statements, comprising:

a. enabling an entity to provide health care reminders as an additional service to end users (customers)(col 2, lines 14-34);

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f., g., & h. receiving and storing end user data relating to a health reminder (col 2, line 53 - col 3, line 2; col 3, lines 16-37; and col 4, lines 10-24);

i. & j. allowing the end user to perform a transaction, resulting in transaction data stored in the system (col 2, lines 17-34); and

k. & l. providing the transaction data and the health care reminder to the end user on a transaction statement (col 1, lines 50-56; col 4, lines 48-52; col 6, lines 27-48; and col 8, lines 3-8).

While Byerly discloses providing the transaction data and the health care reminder during a transaction at a pharmacy, it is also disclosed that the information being printed and presented to the end user includes "billing information". It is common and usual for prescribed pharmaceuticals to be paid for, in whole or in part, by the end user's insurance agency, HMO, PPO, or other third party. Therefore, the information that Byerly is providing to the end user at the pharmacy which includes the "billing information" is the equivalent of a billing statement in that it shows the end user his portion, if any, of the cost of the prescription being filled, especially in view of the disclosure by Byerly that the health care information is being provided by the end user's HMO or PPO.

Bucci also discloses a system and method for providing additional information along with a billing statement mailed through the postal channels to the end user at a later time. Therefore, it would have been obvious to send the health care reminders being presented to the end user in Byerly through the postal mails along with the billing statement. One would have been motivated to send this information through the mail in

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order to present Byerly's reminders to end users whose prescriptions are being filled remotely, e.g. telephonic, mail order, or on-line.

While Byerly and Bucci disclose how health care reminders may be presented to an end user who conducts a transaction, it is not explicitly disclosed on how the end user's credit card being used in the transaction is issued or used (steps b-e in Claims 146 and 176). Masuda discloses a system and method for issuing and using credit cards which comprises:

c. attracting potential end users to said financial cards (i.e. advertising the financial card to the end user by providing the end user with a credit application form)(col 1, lines 19-21). The Examiner notes that it is also common and usual for credit card companies and other companies offering products or services to advertise the availability of their product or service and to direct the potential customer's attention to the positive features of the product or service.

d. & e. converting potential end users into end user by accepting and approving an application for the financial card (col 1, lines 19-25 and 41-48);

b. providing the financial card and related services to the approved end user (col 1, lines 48-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a credit card which had been advertised, issued, and approved in a manner similar to Masuda when conducting the pharmacy transaction in Byerly. One would have been motivated to use such a credit card in order to preclude the end user from having to carry a large amount of cash.

The additional wording in the claims regarding the type of contents contained or not contained in the message, e.g. whether the message reminds the end user of a pre-existing medical appointment or reminds the end user to make a medical appointment, does not affect the steps of providing a message on a billing statement and, thus, is given little if any patentable weight. It would have been obvious that once a system had been set up which places personalized messages on a billing statement, the messages may be directed towards any topic chosen by the message provider.

Likewise, the reason for providing personalized messages on a billing statement, whether to promote a credit card company, promote the HMO providing the messages, or merely to promote better health practices by the end user, is merely the intended use for the claimed invention and does not affect the steps involved in providing a message on a billing statement, thus, is again given little if any patentable weight.

Claims 147 and 177: Byerly, Bucci, and Masuda disclose the system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. While Byerly does not disclose that the billing statement is from a credit card company, Bucci explicitly discloses that the billing statement can be from "such businesses as American Express, AT&T, Blue Cross/Blue Shield, Sears, and Merrill Lynch" (col 2, lines 34-36). At least two of these (American Express and Sears) issue credit cards and send out monthly statements on the amount due by the end user. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the billing statement could be a result of a credit charge to a credit card account owned by the end user. One would have been motivated to place

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the messages on a credit card billing statement to ensure that the end user receives the messages each month, since almost all credit card holders use their credit card at least once each month, whereas many end users may only visit a pharmacy once or twice a year.

Claims 148, 149, 178, and 179: Byerly, Bucci, and Masuda disclose a system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. Bucci further discloses that the billing statement can be from a credit card company, a bank, etc. It is old and well known that banks issue both credit and debit cards some of which may also be used to access ATM machines. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the billing statement could be for purchases made using a credit, debit, or ATM card. One would have been motivated to include these various types of payment cards in order to expand the coverage of the system to include end users with all types of payment cards, since they all send out similar monthly billing statements.

Claims 150 and 180: Byerly, Bucci, and Masuda disclose a system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. Byerly further discloses that the message content may be provided by a variety of third parties (col 2, line 53 – col 3, line 2).

Claims 151-162, 164-174, 181-192, and 194-204: Byerly, Bucci, and Masuda disclose a system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. Masuda also discloses that the end user completes an application form to receive the credit card. Thus, the system is providing the end

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user with prompts, questions, and information concerning not only the credit card itself, but all other aspects of the services and benefits provided by the credit card issuer.

Bucci further discloses that various third parties input data into the system pertaining to the messages being placed on the billing statement. It is inherent that as the various parties input data, the content of the messages being provided to the end user would change, i.e. be modified, revised, updated, or deleted. This would include changes to the personal data or preferences input by the end user, such as a change in marital status, etc. Byerly and Bucci also disclose that the messages could be printed directly on the statement or onto a separate document provided in the same enclosure as the statement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end user in Byerly with prompts, questions, and information concerning the end user data and preferences, payment instrumental data, and other information such as Byerly's "government warnings and news items", and to allow the data contained in the prompts, questions, information, and messages to be modified, revised, updated, or deleted. One would have been motivated to gather, modify, and provide the information in this manner in order to keep the end user informed with the most pertinent messages, such as the latest news items instead of news from the year before.

Claims 163 and 193: Byerly, Bucci, and Masuda disclose a system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. While it is not explicitly disclosed in any of the cited references that the end user will acknowledge receipt of the health reminder, it is old and well known to require such

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acknowledgement, especially if the message pertains to a pending medical appointment. While no specific method of acknowledgement is claimed, it is common for the end user to respond to an appointment reminder by verifying his desire to keep the appointment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the end user to acknowledge receipt of the health care reminder. One would have been motivated to allow the end user to acknowledge receipt in order to preclude annoying the end user by sending the same reminder numerous times.

Claims 175 and 205: Byerly, Bucci, and Masuda disclose a system and method for providing health care reminders on a billing statement as in Claims 146 and 176 above. Bucci further discloses that credit card companies, among others, frequently mail out records, bills, and other documents separately (col 1, lines 12-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the credit card company or any other entity could send the end user health care reminders separately from the billing statement. One would have been motivated to send the reminder separately in order to ensure timely arrival, such as when the reminder is for an appointment that is two days before the billing statement is normally mailed out.

Response to Arguments

5. No arguments were presented in the Response. While any arguments would have been rendered moot in view of the new grounds of rejection above, Applicant is reminded that he should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Zorn (US2002/0046089) discloses a system and method for providing targeted messages to credit card holders, but does not explicitly disclose that the messages are delivered in conjunction with the credit card billing statement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

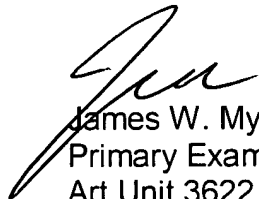
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
April 15, 2004



James W. Myhre
Primary Examiner
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